

REMARKS

The final Office Action mailed September 26, 2007 has been carefully considered.

Within the Office Action Claims 53, 55, 56, 61, 66, and 69-101 have been rejected.

Reconsideration in view of the following remarks is respectfully requested.

B. Final Office Action is Improper

It is well know that “[w]henever, on examination, any claim for a patent is rejected . . . the Director shall notify the applicant thereof, stating the reasons for such rejection . . . together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application . . . “ 35 U.S.C. § 132(a). What is telling in this statute is the mandatory language “shall”. In effect it leaves no discretion with the Director. The only manner in which the Director can properly reject an application is by comporting with the provisions of this statute. The record is clear that this was not done. On the face of the Office action it is stated that “[a] prior art rejection cannot be made because the metes and bounds of the claims are not definite and because the specification does not clarify the claims . . . “ citing *In re Steele*, 305 F. 2d 859, 134 U.S.P.Q. 292 (CCPA 1962). This is sophistry.

The allegation in the Office action states that “the claims are rejected under 35 U.S.C. 112, second paragraph as alleging that the same are incomplete for omitting essential steps, such omission amount to a gap between the steps[, citing] . M.P.E.P. § 2172.01.” See Office action page 4. M.P.E.P. section 2172.01 makes salient that the grounds for the rejection are pursuant to 35 U.S.C. section 112, first paragraph, instead of 35 U.S.C. section 112, second paragraph as alleged in this Office action. The distinction is not cavil. Rather, a rejection pursuant to 35 U.S.C. section 112, second paragraph might support abrogating the requirement to examine the

claims for purposes of 35 U.S.C. section 102 and 103, while a rejection pursuant to 35 U.S.C. section 112, first paragraph would not.

For example, it is alleged in the Office action that “the specification does not clarify the claims.” See Office action page 5. However, the Office action identifies no less than five pages of the written specification in support of the contention that the claims fail to describe the necessary steps needed to implement a selective disturbance filter. See Office action page 3. Specifically, to support the rejection pursuant to 35 U.S.C. section 112, the Office action refers to the text bridging page 33 line 1 to page 36, line 32 and page 24, line 18 to page 25, line 25. The logical paucity presented by the assertion that the specification can not clarify the meanings of the claims when reference is made to the same in support of the rejection further detracts from the examiner’s rationale for failing to examine the claims in view of the prior art. Applicants contend, therefor, that the Office action fails to comport with the provisions of 35 U.S.C. section 132(a), because the examiner admits to not examining the claimed invention to determine whether the same is patentable in view of 35 U.S.C. section 102 and 103.

Further support for Applicant’s contention that the provisions of 35 U.S.C. section 132(a) have not been satisfied is found in 37 C.F.R. section 1.104, wherein it states the following:

On taking up an application for examination . . . the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application . . . with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated. See 37 C.F.R. § 1.104(a)(1)(emphasis added)

The provisions of this regulation mandates an examiner to make a thorough study of the prior art and examine the patentability of a claimed invention in view thereof. Moreover, M.P.E.P. section 704.01 makes clear that piecemeal prosecution is to be avoided by requiring an examiner

to search the prior art even if a case is informal and can only be imperfectly understood. See M.P.E.P. § 704.01 (“informal cases, or those which can only be imperfectly understood when they come up for action in their regular turn are also given a search, in order to avoid piecemeal prosecution.”). Thus, it cannot be said that the Director has properly examined the application pursuant to 35 U.S.C. section 132 for the reasons set forth above.

It appears that the examiner relies upon the holding of *In re Steele*, 134 U.S.P.Q. 292 (CCPA 1962) to support the examiner’s abdication of responsibility to search and examine the claims to determine patentability pursuant to 35 U.S.C. sections 102 and 103. The fallacy in the examiner’s reliance upon *In re Steele* is manifold. *In re Steele* stands for nothing more than that an examiner need not search claims in which there is considerable speculation as to the meaning of terms employed in the claims and a number of assumptions respecting the scope of the claims. See *Ex parte Saceman*, 27 U.S.P.Q. 2d 1472 (BPAI 1993). As a result, it is claims that violate 35 U.S.C. section 112, second paragraph that may render proper abdication of the examiner to fulfill the mandates of 35 U.S.C. section 132, 37 C.F.R. section 1.104 and M.P.E.P. section 704.01. See *Ex part Tanskley*, 26 U.S.P.Q. 2d 1384, 386 (BPAI 1991), quoting *In re Merat*, 186 U.S.P.Q. 471 (CCPA 1975) (a finding under the second paragraph of 35 U.S.C. 112 for indefiniteness “renders it unnecessary to discuss the other grounds of rejection,” one of which was a rejection under 35 U.S.C. 103 based on the prior art.”)(quotes in original). However, as set forth above, the rejection provided by the examiner is properly based upon 35 U.S.C. section 112, first paragraph and not 35 U.S.C. section 112, second paragraph, as alleged by the examiner. Therefore, considering that the examiner failed to satisfy the requirements of the patent laws, patent regulations, as well as the practices and procedures of the United States Patent and Trademark Office, it is contended that the Final office action is improper.

Reconsideration of the Office action is respectfully requested and a new, complete, office action is requested.

Information Disclosure Statement

On March 1, 2007 Applicants submitted an Information Disclosure Statement and paper copies of 24 references. There has been no indication that these references have been considered. The Examiner is respectfully requested to consider these references as required by the rules. In the present Office action the examiner objects to the original manner in which the references were brought to the attention of the Examiner three years ago. The relevance of this assertion is ephermal at best considering that the paper copies are now before the Examiner. Moreover, the Examiner is reminded that the PTO1449 is merely a convenient manner by which to bring information to the attention of the Examiner. See MPEP§ 609.04(a). Applicants' duty pursuant to 37 CFR 1.56 requires nothing more than Applicants provide paper copies of the references. This has been done. See copy of postcard mailed 7 March 2007 attached hereto. Therefore, the Examiner MUST consider these references as they have been filed in the Application. Evidence of the consideration of the references is requested. See MPEP§ 609.05.

The 35 U.S.C. § 112 Second Paragraph Rejection

It is submitted that the rejection of the claims premised upon 35 U.S.C. section 112, second paragraph are completely without merit. As set forth above, the proper rejection based upon the Examiner's reasoning would have been 35 U.S.C. section 112, first paragraph. Nonetheless, it is Applicants' contention that the claims comport with the requirements of 35 U.S.C. section 112, first paragraph. Specifically, it appears that the Examiner seeks to have Applicants amend the claims to include the features listed on no less than 6 pages of the application. As a result, the present situation has nothing to do with a missing element of a

claimed method as was the case of *In re Mayhew*, 188 U.S.P.Q. 356 (CCPA 1976). Rather, this is a matter of the Office requiring Applicants to limit the claims to the specific embodiments disclosed. As stated succinctly by the predecessor court of the Federal Circuit. “[t]o demand that the first to disclose shall limit his claims to what he has found will work . . . in a process . . . involved would not serve the constitutional purpose of promoting progress in the useful arts.” *In re Goffe*, 192 U.S.P.Q. 427 (CCPA 1976). Applicants submit that the claims properly define the scope of the invention as enabled by the specification. Therefore, it is respectfully submitted that the claims comport with the provisions of 35 U.S.C. section 112.

Conclusion

In view of the foregoing, reconsideration and an early allowance of this application are earnestly solicited.

If any matters remain which could be resolved in a telephone interview between the Examiner and the undersigned, the Examiner is invited to call the undersigned to expedite resolution of any such matters. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

Dated:

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